

A. The Proper Test For a Restriction Requirement.

Applicant respectfully submits that Paper No. 4 does not support the necessary conditions for a proper restriction requirement. A requirement for restriction under MPEP § 803 is proper between two claimed inventions where the following conditions have both been satisfied: (1) the inventions are independent or distinct as claimed, and (2) the Examiner is under a serious burden if restriction is not required. See MPEP § 803 et seq. As shown below, neither of these conditions have been satisfied by Paper no. 4. Consequently, the requirement for restriction should be withdrawn.

B. The Claims are Interrelated

The Restriction Requirement groups the claims into five (5) categories, for a "5-way" restriction. The Examiner characterizes Group I claims 1-38 as being drawn to Database and Data Structure Generation. Group II claims 22-26 are characterized as drawn to Database Searching. Group III claims 39-54 and 60-79 are characterized as drawn to Database Display. Group IV claims 55-59 are characterized as drawn to Integration of Applications. Group V claims 80-98 are characterized as drawn to Web Browsing.

Therefore, as characterized by the Examiner, three of the groups of claims relate to a Database Application. The search and examination of these claims is interrelated in that consideration must be given to Database Applications which generally are capable of generating, searching, and displaying a database. A three way restriction based on the treatment of the database is inappropriate and unduly limits examination based on the type of treatment of the database.

Further evidence of interrelation of the claims is shown by looking to the claims themselves. For example, claims 20 and 29, which are in Group I, include a step of "searching ... in a database." Claims 1-11 and 18-21 are methods of "analyzing a database," while claims 22, 23, 25, and 26 of Group II include a step of "analyzing a database." Claim 38 is a method of "representing ... and for computerized searching" as is Claim 24, yet these two claims (38 and 24) are in separate Groups. As is shown by these examples, the claims of Groups I and II are interrelated and belong in the same group.

The case of interrelation is even stronger between the claims of Group I and III. Claims 1- 13, 18-21, and 27-38 all include steps related to "displaying." More to the point, claim 6 includes a step of "generating graphics to display" while claim 21 includes a step of "generating graphical display." Claims 1-38, 39-54, and 60-79 are interrelated and should be grouped together. The Examiner will have to search the same fields for these claims, and he will not be under a serious burden if restriction is not required as to these groupings. Therefore, the claims of Groups I, II, and III should not be restricted.

B. The Claims are Misclassified

The Examiner contends that the groups each have a separate utility, as evidenced by their separate classification, and therefore, they are distinct from each other. One problem with this contention is that the groups are misclassified, based on how the Examiner has characterized them. The Examiner has characterized claims 1-38 as drawn to Database and Data Structure Generation. As such, the Examiner classified this group in class 395, subclass 615. Subclass 615 is titled

"application of database or data structure." However, subclass 613 is titled "Generating Database or Data Structure," and is the correct subclass for claims drawn to "Database or Data Structure Generation." Therefore, claims 1-38 should be classified in class 395, subclass 613, which is the same classification the Examiner has given to claims 39-54 and 60-79.

Since claims 1-38, 39-54 and 60-79, should have the same classification, their classification does not evidence their alleged distinctiveness. Furthermore, having the same classification evidences the lack of a burden for the Examiner in examining these claims. Therefore, the claims of Groups I, II and III do not meet the requirements for a restriction requirement, and should not be restricted.

C. The Fields of Search for Groups I, II, III, and V Are Neighboring.

In the present case, the Examiner states no reason why examination of the entire case is a "burden," but apparently relies on different fields of search (based on different classifications of Groups I-V). See p. 2 of Restriction Requirement.

The Examiner's logic, even if true, is not persuasive. Four of the groups have classifications that are near to each other. Ignoring the above arguments regarding the misclassification of the Groups I and III for the moment, Groups I and III have classifications of 395,615 and 613, respectively. As such, these Groups are within two subclasses of one another. Furthermore, Groups II and V have classifications of 395,603 and 601, respectively, which are also within two subclasses of one another. For these four groupings, the classifications are so close that they do not evidence a burden on the Examiner, as is required for a restriction requirement. Therefore, the claims of Group I, II, III, and V should not be restricted.

CONCLUSION

The restriction requirement, except as applied to Group IV, should be reconsidered and withdrawn because the Examiner has not met the two prong test of showing both (1) distinctness, and (2) a burden in examination.


If the restriction requirement is maintained, applicant provisionally elects Group I, with the additional request that the Examiner includes claims 39-54 and 60-79 within Group I. The Examiner has failed to show a burden, as is required for a restriction requirement. Further, if the restriction is maintained, it should be rewritten into a three-way restriction, grouping claims 1-38, 39-54, and 60-79 in Group I, claims 55-59 in Group II, and claims 80-98 in Group III.

An action on the merits is respectfully requested.

Respectfully submitted,

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